

("Horiuchi") and U.S. Patent No. 5,904,799 to Dhindsa et al. ("Dhindsa"); rejected claims 28, 29, 30, and 32 under 35 U.S.C. § 103(a) as unpatentable over Moriya in view of Horiuchi; and rejected claim 31 under 35 U.S.C. § 103(a) as unpatentable over Moriya in view of Horiuchi and further in view of Dhindsa. Applicants respectfully traverse these rejections as set forth in the following remarks.

Applicants respectfully traverse the rejections of claims 23-32, as detailed above, for the following reasons. Applicants respectfully disagree with the Examiner's arguments and conclusions, and submit that a prima facie case of obviousness has not been established.

Applicants respectfully note that "the examiner bears the initial burden, on review of the prior art on any other ground, of presenting a prima facie case of unpatentability." In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (Emphasis original). To establish a prima facie case of unpatentability, three basic criteria must be met. First, the prior art references, when combined, must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Finally, there must be a reasonable expectation of success M.P.E.P. §2143.

Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. In Re Vaeck, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." In Re Dembiczak,

175 F.3d 994, 999 (Fed. Cir. 1999). As will be described below, modifying the cited references is improper.

Independent claim 23 recites a method including, among other limitations, "a step of opening a means for opening/closing. . . during the moving operation of said electrode." The cited prior art references, even if they could properly be combined as suggested by the Examiner, would fail to teach or suggest the claimed invention. Moriya discloses a gate valve 304 that shields the etching chamber 301 from the auxiliary vacuum chamber 302. When the auxiliary vacuum chamber 302 is under normal pressure, the gate valve 304 is opened. (Col. 11, lines 54-62). Komino discloses a susceptor at a lowered position during wafer transfer and at a raised position during plasma etching. (Col. 14, lines 12-19). Komino and Moriya do not teach or suggest any method where a gate valve of Moriya is opened "during" the time the susceptor of Komino is allegedly lowered. Applicants assert that Komino and Moriya, as combined by the Examiner, do not disclose or suggest the claimed invention. In particular, there is no disclosure or suggestion of any relationship between the "step of opening, " allegedly shown in Moriya and the "moving operation of the electrode," assertedly shown in Komino. For at least this reason, Applicants respectfully request allowance of claim 23 and its dependent claims 24-27.

Independent claim 28 recites, among other things, "a step of opening a means for opening/closing. . . after the step of plasma processing" and "a step in which said electrode is moved. . . after the means for opening/closing is opened." The cited prior art references, even if they could properly be combined as suggested by the Examiner, would fail to teach or suggest the claimed invention. Horiuchi discloses conveying a

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substrate or semiconductor wafer 13 to be process d into reaction container 1, and then placing the semiconductor wafer 13 in contact the upper surface of lower block electrode 14. (Col. 4, line 62 through col. 5, line 7). Only after the substrate or semiconductor 13 of Horiuchi is conveyed into reaction container 1 is the semiconductor wafer etched by the plasma of the reaction gas. (Col. 5, lines 37-38). In contrast, independent claim 28 recites that the "electrode is moved. . . after the means for opening/closing is opened," and that the "means for opening/closing" is opened "after the step of plasma processing." Accordingly, independent claim 28 recites that the "electrode is moved" "after the step of plasma processing." This is neither taught nor suggested by the cited prior art references. For at least this reason, Applicants respectfully request allowance of claim 28 and its dependent claims 29-32.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in this Request for Reconsideration, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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